



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

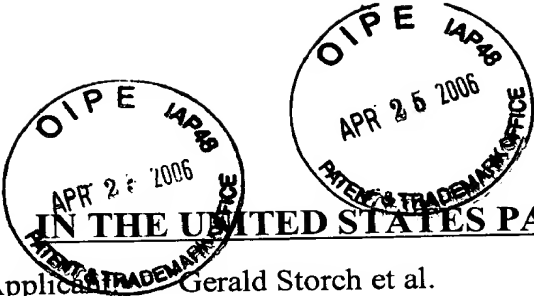
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) T634.112.101	
<p>I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax. No. (571) 273-8300</p> <p>on <u>April 20, 2006</u></p> <p>Signature <u><i>Matthew B. McNutt</i></u></p> <p>Typed or printed name <u>Matthew B. McNutt</u></p>		Application Number 09/865,893	Filed May 25, 2001
		First Named Inventor Gerald Storch et al.	
		Art Unit 3627	Examiner Kramer, James A.
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. 39,766 Registration number</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34</p> <p><u><i>Matthew B. McNutt</i></u> Signature Matthew B. McNutt Typed or printed name 612-767-2510 Telephone number April 20, 2006 Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<p><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



EXPEDITED PROCEDURE
Examining Group Number 3627

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Gerald Storch et al.

Examiner: Kramer, James A.

Serial No.: 09/865,893

Group Art Unit: 3627

Filed: May 25, 2001

Docket: T634.112.101

Title: CO-BRANDED INTERNET SERVICE PROVIDER AND RETAILER INTERNET
SERVICE SITE WITH RETAILER-OFFERED INCENTIVES FOR MEMBER USE

COMMENTS ACCOMPANYING REQUEST
FOR PRE-APPEAL BRIEF REVIEW

Mail Stop AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

These Comments accompany the Request for Pre-Appeal Brief Review filed
therewith. Please consider the following during the Pre-Appeal Brief Conference:

Claims 1-5, 11-24 and 31 stand rejected under 35 U.S.C. §103(a) as being
unpatentable over Tobin in view of "American Interactive Media and Shopping.com
Announce Strategic Marketing Agreement" (hereinafter AIME).

Appellants respectfully submit that Tobin and AIME, individually and in
combination, fail to teach or suggest all the limitations of independent claims 1 and 31. In
particular, Tobin and AIME fail to teach or suggest *at least* **"providing the members with a
discount on subscription fees for access to the co-branded Internet site based upon a
quantity of merchandise purchased from the retailer."** The Final Office Action mailed
12/20/05 acknowledges that Tobin does not specifically teach wherein providing members
incentives comprises providing members with a discount on subscription fees for access to
the co-branded Internet site based upon quantity of merchandise purchased from the retailer
(p. 3, lines 4-6), and cites AIME as teaching accumulation of "Maximizer Dollars."
However, Appellants submit that **AIME is completely silent and provides absolutely no
teaching or suggestion regarding how "Maximizer Dollars" may be accumulated.** The
teachings of AIME regarding discounted or free Internet access are limited to a single
statement that "Benefits include no set up fees, and the ability to accumulate and redeem
'Maximizer Dollars' for discounted or free internet access." There is no teaching or

Amendment under 37 C.F.R. 1.116

Applicant: Gerald Storch et al.

Serial No.: 09/865,893

Filed: May 25, 2001

Docket No.: T634.112.101

Title: CO-BRANDED INTERNET SERVICE PROVIDER AND RETAILER INTERNET SERVICE SITE WITH RETAILER-OFFERED INCENTIVES FOR MEMBER USE

suggestion in AIME that accumulation of “Maximizer Dollars” are related to a quantity of merchandise purchased from the retailer. In response to the deficiencies of AIME as pointed out above by Appellants, the Advisory Action mailed 3/20/06, introduces a *new reference* (i.e., “Shopping.com Announces the Grand Opening of the Internet’s First Full Service Retail Destination Hub Site”) as teaching that Maximizer Dollars taught in AIME are inherently accumulated based on the purchase of products and/or services from Shopping.com. Appellants submit that the introduction of a *new reference* requires withdrawal of the finality of the Office Action, and issuance of a new non-final action. In view of the above, Appellants request withdrawal of the rejection of claims 1 and 31 and the claims depending therefrom under 35 U.S.C. 103(a) as being unpatentable over Tobin in view of AIME.

Claims 6 and 7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Tobin in view of AIME, and further in view of Staples.com. The Office Action acknowledges that the Tobin/AIME combination fails to teach providing members with access to advertising circular content for the Internet shopping site through the co-branded Internet site before corresponding printed advertising circulars are distributed (claim 6), and further that the combination fails to teach providing members with notice of store-based clearances, promotional events and/or special events through the co-branded Internet site before publishing notices for such special events to non-members (claim 7). The Office Action and Advisory Action cite Staples.com as allegedly overcoming the acknowledged deficiencies of the Tobin/AIME combination.

With regard to claim 6, Appellants submit there is no teaching or suggestion in Staples.com that the “Staples Specials for 2/29/00” are in any way related to *printed* advertising circular content. The Advisory Action states one skilled in the art would recognize the “Special” as “content that would/could be contained in a circular and as such it clearly represents circular content.” However, the fact that a special “could be” contained in a printed circular does not constitute a teaching or suggestion that it is contained in a printed circular. Further, *even if* the Staples “Specials” were related to a printed advertising circular, there is no teaching that the information presented on the Internet site is available **before corresponding printed advertising circulars are distributed**, as set forth in claim 6. Such teaching is found only in Appellants’ disclosure.

Amendment under 37 C.F.R. 1.116

Applicant: Gerald Storch et al.

Serial No.: 09/865,893

Filed: May 25, 2001

Docket No.: T634.112.101

Title: CO-BRANDED INTERNET SERVICE PROVIDER AND RETAILER INTERNET SERVICE SITE WITH RETAILER-OFFERED INCENTIVES FOR MEMBER USE

With regard to claim 7, the Office Action alleges that the Staples.com “News and Hot Product Offers” represents Appellants’ claimed **notice of store-based clearances, promotional events and/or special events through the co-branded Internet site before publishing notices for such special events to non-members**. Contrary to the characterization of Staples.com set forth in the Office Action, Appellants submit there is no teaching or suggestion in Staples.com that the “News and Hot Product Offers” are provided to one class of users (i.e., members) before being provided to another class of users (i.e., non-members). The entering of an e-mail address simply allows a user to receive the “News and Hot Product Offers” in a different manner (i.e., via e-mail, rather than visiting the retailer’s web site directly). There is no teaching or suggestion that the e-mail recipients receive the news and product offers *before the news and product offers are offered on the web site*. Such teaching is found only in Appellants’ disclosure.

In view of the above, Appellants respectfully submit claims 6 and 7 are allowable over the cited references, and withdrawal of the rejection of claims 6 and 7 under 35 U.S.C. 103(a) is respectfully requested.

Independent claim 30 stands rejected under U.S.C. §103(a) as being unpatentable over Tobin in view of AIME, further in view of “AOL” Wal-Mart next to team on Net service” by Sandeep Junnakar (hereinafter Junnakar), and further in view of “IBM to sell Aptiva direct” by Joe Wilcox (hereinafter Wilcox). The Office Action acknowledges that the combination of Tobin, AIME and Junnakar fails to teach providing to members a link to news articles and a link to a page on the Internet shopping site offering for sale a product featured in the news article. To overcome the acknowledged deficiencies, Wilcox is cited as evidence that it is old and well known to include within news articles links to product pages that sell the products featured in the article.

Appellants submit that the cited references, individually and in combination, fail to teach or suggest *at least* **“providing to members a link to a news article and a link to a page on the Internet shopping site offering for sale a product featured in the news article.”** Although Tobin teaches links to news articles (e.g., as in Fig. 11A), the links in Tobin are links having *disparate* content (e.g., “Money Personal Finance”; “Sports”; “Techwatch” as shown in Fig. 11A of Tobin). Wilcox teaches news articles having

Amendment under 37 C.F.R. 1.116

Applicant: Gerald Storch et al.

Serial No.: 09/865,893

Filed: May 25, 2001

Docket No.: T634.112.101

Title: CO-BRANDED INTERNET SERVICE PROVIDER AND RETAILER INTERNET SERVICE SITE WITH RETAILER-OFFERED INCENTIVES FOR MEMBER USE

embedded links to product pages that sell the products featured in the article. However, in Wilcox, a user can only access the link to a page offering for sale a product featured in the news article after accessing the news article. That is, Wilcox teaches “serial” access to the links. The user is not provided **a link to a news article and a link to a page offering for sale a product featured in the news article**. AIME and Junnakar both fail to remedy the deficiencies of Tobin and Wilcox, as neither AIME nor Junnakar teach or suggest providing a link to a news article and a link to a page on the Internet shopping site offering for sale a product featured in the news article. In view of the above, Appellants respectfully submit independent claim 30 is in allowable condition and request withdrawal of the rejection of under 35 U.S.C. 103(a).

Claim 32 stands rejected under U.S.C. §103(a) as being unpatentable over Tobin in view of AIME, and further in view of “Snafu prompts Microsoft to suspend some PC rebates” by Michael Kannellos (hereinafter Kannellos). The Office Action acknowledges that the combination of Tobin and AIME fails to teach providing members with a discount on merchandise purchased wherein the rate of merchandise discount and period of time of which the discount is available varies on the basis of the length of member’s subscription to the Internet service provider. To overcome the acknowledged deficiencies, the Office Action cites Kannellos as allegedly teaching that at the time of the Appellants’ invention it was well known for Internet service providers to give customers discounts on products at affiliated retail stores based on the length of the customer’s subscription to the Internet service provider. In the specific case of Kannellos, customers that agreed to a 3 year subscription were given a \$400 rebate to an affiliated retail store. The Advisory Action states “a three year subscription is a length of member’s subscription and therefore offering a discount for this purchase represents a discount based on the length of a subscription.”

Contrary to the characterization of Kannellos set forth in the Office Action, Kannellos does not teach or suggest **a rate of the merchandise discount varies on the basis of the length of a member’s subscription, and further does not teach or suggest a period of time over which the merchandise discount is available varies on the basis of the length of a member’s subscription**. Rather, the rate of merchandise discount in Kannellos is dependent upon the product purchased (i.e., buy a three year subscription and receive a \$400

Amendment under 37 C.F.R. 1.116

Applicant: Gerald Storch et al.

Serial No.: 09/865,893

Filed: May 25, 2001

Docket No.: T634.112.101

Title: CO-BRANDED INTERNET SERVICE PROVIDER AND RETAILER INTERNET SERVICE SITE
WITH RETAILER-OFFERED INCENTIVES FOR MEMBER USE

discount), and does not vary on the basis of the length of a member's subscription. There is no teaching or suggestion that the rate of merchandise discount varies even on the basis of the product purchased, much less the length of a member's subscription. Finally, Kannellos makes no teaching regarding *how long* the discount is available. The only mention of a time period in Kannellos is with respect to the product purchased (i.e., a three year subscription). Thus, Kannellos cannot be said to teach or suggest that the period of time over which the merchandise discount is available varies on the basis of the length of a member's subscription. Rather, such teaching is found only in Appellants' disclosure. In view of the above, Appellants respectfully submit independent claim 32 is in allowable condition and request withdrawal of the rejection under 35 U.S.C. 103(a).

The Examiner is invited to contact the Appellants' representative at the below-listed telephone numbers to facilitate prosecution of this application.

Customer number 025281
Dicke, Billig & Czaja, PLLC
Fifth Street Towers, Suite 2250
100 South Fifth Street
Minneapolis, MN 55402
Telephone: (612) 573-2000
Facsimile: (612) 573-2005

Respectfully submitted,



Matthew B. McNutt
Reg. 39,766

CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 20th day of April, 2006.

By 
Name: Matthew B. McNutt